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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,781	08/10/1999	CRAIG A. WILL	03384.0348	9650

22852 7590 09/06/2002

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EXAMINER

KNOWLIN, THJUAN P

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/371,781

Applicant(s)

WILL, CRAIG A.

Examiner

Thjuan P Knowlin

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-2, 6, 8-13, 17, 19, 20-36, 38-39, and 41-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Goedken (US 6,393,423).
2. In regards to claims 1, 2, 9, 10, 11, 12, 13, 22, 23, 24, 27, 29, 30, 33, Goedken discloses a method for real-time communication among two or more individuals separated in space ("chat room"), comprising the steps of: determining that a first individual is likely to be interested in communicating with a second individual via a first communication link; retrieving information via the first communications link about one or more additional individuals from electronic memory means associated with the second individual ("directory of potential participants"); and establishing communication with at

least one of the additional individuals ("private room") based on the retrieved information (col. 2-3 lines 58-2).

3. In regards to claims 6, 8, 17, 19, 38, 39, and 42, Goedken discloses the method, wherein the communication established between the first and second individuals comprises exchanges or text messages (col. 2-3 lines 64-2).

4. In regards to claims 34, 35, 36, 41, 43, 44, and 45, Goedken discloses a collaborative conferencing system comprising: a large virtual space room; a display for displaying in real-time a representation of only those persons in the virtual space room who have been defined as likely to be interesting; and means for establishing communications with the persons in the virtual space room (col. 2-3 lines 58-2).

5. In regards to claim 12, Goedken discloses the method, wherein the information in the memory is obtained by observing previous communications between the second individual and one of the individuals in the memory (col. 17-18 lines 62-12).

6. In regards to claims 20, 21, 25, 26, 28, 31, and 32, Goedken discloses the method, wherein from observing previous communications between the second individual and one of the individuals in the memory, the frequency with which the second individual communicates with the individuals in the memory is determined and the individuals are sorted in the memory according to the frequency of communication (col. 14 lines 43-67 and col. 17-18 lines 62-12).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goedken (US 6,393,423).

8. Goedken discloses all of claims 7 and 18 limitations except the method, wherein the first and second individuals communicate via real-time video. However, it is well known in the art to use real-time video (e.g. webcam) as a way of communicating. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to employ the method with real-time video (e.g. webcam). People may prefer real-time video over text or voice communication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 4, 5, 14, 15, 16, 37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goedken (US 6,393,423), and further in view of Leipow (US 6,148,067).

10. Goedken discloses all of claims 3, 4, 14, 15, and 37 limitations except the method, wherein the communication established between the first and second individuals is by real-time telephony. Leipow, however, discloses the method, wherein the communication established between the first and second individuals is by real-time telephony (Fig. 1 and col. 2-3 lines 64-5). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention, to employ the method with real-time telephony, as a way of allowing parties engaged in on-line "chat" rooms, to communicate with each other via the telephone network using telephone stations. Again, people may prefer speaking with someone instead of "chatting" in an Internet chat room.

11. Claims 5, 16, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goedken (US 6,393,423), Leipow (US 6,148,067), and further in view of Herz (US 6,029,195).

12. Goedken and Leipow disclose all of claims 5, 16, and 40 limitations except the method, wherein the communications established between the first and second individuals comprises exchanges of voice mail messages. Herz, however, discloses the method, wherein the communications established between the first and second individuals comprises exchanges of voice mail messages (col. 80 lines 4-17 and col. 81 lines 14-25). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to employ the method with exchanges of voice mail messages, as a way of allowing users to communicate with each other through the use of voice mail messages, which may be preferred over text messages

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. De Boor et al (US 6,317,781) teach a wireless communications device with markup language based man-machine interface.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P Knowlin whose telephone number is (703) 308-1727. The examiner can normally be reached on Mon-Fri 8:00-4:30pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703)305-4731. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Thjuan P. Knowlin
August 30, 2002



AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

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